



Attorney Docket No. YOR920000164US1

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicant(s): A. Dan et al.
Docket No.: YOR920000164US1
Serial No.: 09/642,526
Filing Date: August 18, 2000
Group: 3626
Examiner: Joseph Thomas

I hereby certify that this paper is being deposited on this date with the U.S. Postal Service as first class mail addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Signature: V. Benckmann Date: October 19, 2004

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GROUP 3600

Title: Electronic Service Level Agreement for
Web Site and Computer Services Hosting

TRANSMITTAL OF REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is the following document relating to the above-identified patent application:

(1) Reply Brief (original and two copies).

It is believed that there is no additional fee due in conjunction with the response. In the event of any non-payment or improper payment of a required fee, the Commissioner is hereby authorized to charge or to credit **International Business Machines Corporation Deposit Account No. 50-0510** as required to correct the error. Duplicate copies of the Reply Brief are enclosed.

Respectfully submitted,

Date: October 19, 2004

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GROUP 3600

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Sir:

This Reply Brief is submitted in response to the Examiner's Answer dated August 19, 2004 in the above-referenced application.

STATUS OF AMENDMENTS

The Examiner in his Answer to the Appeal Brief filed by Applicants (hereinafter "Appellants") on January 21, 2004, asserts that an amendment after final rejection filed on November 21, 2003 has been entered. However, while a Response to Final Office Action was filed on November 19, 2003, there have been no amendments to the claims or specification filed subsequent to the final rejection.

ARGUMENT

The Examiner in his Answer to the Appeal Brief filed by Appellants on January 21, 2004, reasserts his arguments that claims 1-6, 10-18 and 22-26 are anticipated under 35 U.S.C. §102(b),

and claims 7-9 and 19-21 are unpatentable under 35 U.S.C. §103(a). Appellants respectfully disagree with the assertions presented by the Examiner in the Answer, for at least the reasons identified below, as well as for those reasons previously set forth in the Appeal Brief.

(I) With regard to the issue of whether claims 1-6, 10-18 and 22-26 are properly rejected under 35 U.S.C. §102(b) as being anticipated by O'Brien, the Examiner's Answer contends that O'Brien discloses all of the claim limitations recited in the subject claims. Appellants respectfully reassert that O'Brien fails to disclose all the claim limitations of the subject claims for at least the reasons previously presented in the Appellant's Appeal Brief.

Additionally, Appellants assert that O'Brien fails to disclose a computer hosting services environment. O'Brien instead discloses a service provisioning system, which provides services from agents in a distributed processing environment. O'Brien does not disclose client applications requesting hosting by a service provider. The nature of the computer hosting services environment of the present invention results in the need for electronic service level agreements between a client and a service provider. The service provisioning system environment of O'Brien does not result in a need for service level agreements (SLAs) between an agent and a client, since services are simply provisioned from the agent to the client based on an existing SLAs from agent to agent.

On pages 7 and 8 of the Examiner's Answer, the Examiner contends that decisions to provide a service in O'Brien are based on stored parameters that might include the amount of work already being done by the system, which is based on SLAs that were committed to by the agent. Further, the Examiner contends that each time a service has been provided information such as actual cost data and actual time taken, may be used to adjust the parameters. Finally, the Examiner contends that these statements evidence a check of consistency of a proposed SLA against stored parameters based on existing SLAs. Appellants strongly disagree.

Appellants contend that the Examiner has mischaracterized O'Brien in rejecting the elements of the present invention. Specifically, the Examiner seems to confuse the services provided by the agent in response to a service request, and the contracts, or SLAs, formed between agents in order to provide necessary services in response to the service request. In O'Brien, the agent receives a service request and identifies component processes used in provisioning the requested service. The

agent then negotiates with other agents in order to access any needed component processes in fulfilling the requested service. Thus, services provided by an agent in response to a service request in O'Brien are not SLAs, as SLAs exist only between agents.

Much of the Examiner's argument as provided on pages 7 and 8 of the Examiner's Answer, relies on the description on pages 6 and 7 of O'Brien. However, these pages describe the providing of a service from an agent in response to a service request sent to the agent. The "parameters indicative of availability" referred to by the Examiner, is the actual SLA of the agent, which is a contract provided from one agent to another agent. See, for example, O'Brien, page 3, lines 18-22 and page 18, lines 12-15. While the SLA of the agent may include the amount of work being done by the system, and may be updated to include actual cost data and time taken, the SLA of the agent is a reference in providing a service based on a service request, and not in providing another SLA.

The actual invention of O'Brien is discussed on pages 16-19, which describe the different modules of the agent, and the responsibilities of each module. The contracts, or SLAs, that the agent has made with other agents in order to provide specific services are also described on these pages and are a result of negotiation and verbalization of demands between agents.

Therefore, O'Brien fails to disclose the construction of an electronic service level agreement between a service provider and a client based on client input for an application associated with the client to be hosted by the service provider as recited in the independent claims of the present invention. As discussed above, the SLAs of O'Brien are not based on applications for the client to be hosted by the service provider. Further, the SLAs negotiated and constructed in O'Brien are not between a service provider and a client.

O'Brien also fails to disclose a consistency check of the electronic service level agreement with respect to one or more existing electronic service level agreements previously committed to by the service provider as recited in the independent claims of the present invention. The agent of O'Brien only provides a requested service which is checked with regard to the SLA of the agent, and does not provide SLAs to clients. There cannot be a check for consistency between SLAs when an SLA provided for the client does not exist. Finally, while a single agent may have multiple contracts, these contracts are with other agents and not a client, and O'Brien does not disclose a consistency check of a contract with respect to existing contracts of the agent.

Dependent claims 2-8, 12, 14-18 and 22-24 are patentable for at least the reasons that independent claims 1, 13, 25 and 26 are patentable. In addition, it is asserted that dependent claims 2-8, 12, 14-18 and 22-24 each recite patentable subject matter in their own right.

Therefore, for at least the reasons given above and those presented in the Appellants' Appeal Brief, Appellants again respectfully request that the §102(b) rejections of claims 1-6, 10-18 and 22-26 be withdrawn.

(II) With regard to the issue of whether claims 7-9 and 19-21 are properly rejected under 35 U.S.C. §103(a), Appellants respectfully reassert that the cited combination fails to establish a prima facie case of obviousness under 35 U.S.C. §103(a), as specified in M.P.E.P. §2143 for at least the reasons previously presented in the Appellants Appeal Brief.

Additionally, the collective teaching of O'Brien and Main fails to suggest or render obvious the elements of claims 7-9 and 19-21, since neither O'Brien nor Main disclose a computer hosting services environment in which SLAs are constructed and checked based on applications from the client to be hosted by the service provider. Therefore, the combination of O'Brien and Main fails to teach or suggest all the limitations of claims 7-9 and 19-21. For at least this reason, a prima facie case of obviousness has not been established.

Appellants reassert that no motivation or suggestion exists to combine O'Brien and Main in a manner proposed by the Examiner, or to modify their teachings to meet the claim limitations.

It is well-settled law that "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (emphasis in original). Moreover, in order to avoid the improper use of a hindsight-based obviousness analysis, particular findings must be made as to why one skilled in the relevant art, having no knowledge of the claimed invention, would have selected the components disclosed by O'Brien and Main in the manner claimed (*See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). The Examiner's conclusory statements providing that the motivation is "alerting service requestor of the potential impact of SLA violation" (Examiner's Answer; page 6, lines 13-14; and page 7, lines 3-4) do not adequately address the issue of motivation to combine references. "It is improper, in determining whether a person of ordinary

skill would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'" *In re Sang-Su Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002) (quoting *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)).

On page 12 of the Examiner's Answer, the Examiner contends that "each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specifically support that particular modification." However, the only portion of either reference provided is "(Main;abstract)." The abstract of Main simply provides a short description of the invention provided in Main, and does not provide a motivation to incorporate the invention of Main into the invention of O'Brien. For at least this reason, a prima facie case of obviousness has not been established.

Lastly, Appellants reassert that there is no reasonable expectation of success in achieving the present invention through a combination of O'Brien and Main. Despite the assertion in the Examiner's Answer, Appellants do not believe that O'Brien and Main are combinable since it is not clear how one would combine them. No guidance was provided in the Examiner's Answer as to how the two references can be combined to achieve the present invention. The invention of O'Brien provisions services from an agent in response to a service request, while Main discloses an automatic notification of a user if the SLA is in danger of not being met. The user of O'Brien does not have an SLA and is not concerned with the construction or requirements of the SLA of the agent. Therefore, the automatic notification of Main cannot be employed in the service provision system of O'Brien, and vice versa. Thus, there is no reasonable expectation of success in achieving the present invention through a combination of O'Brien and Main. However, even if combined, for the sake of argument, they would not achieve the techniques of the claimed invention. For at least this reason, a prima facie case of obviousness has not been established.

Therefore, for at least the reasons given above and those previously provided in the Appellants' Appeal Brief, Appellants again respectfully request that the §103(a) rejections of claims 7-9 and 19-21 be withdrawn.

For at least the reasons given above and those previously provided in Appellants' Appeal Brief, Appellants respectfully request withdrawal of the §102(b) and §103(a) rejections of claims 1-26. Appellants believe that claims 1-6, 10-18 and 22-26 are patentable over O'Brien, and claims 7-9

and 19-21 are not obvious in view of O'Brien and Main. As such, the application is asserted to be in condition for allowance, and favorable action is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, reading "Robert W. Griffith". The signature is written in a cursive, flowing style with a large initial 'R'.

Date: October 19, 2004

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